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Attorney's Docket No.: 01082-010006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Falciglia et al. ✓
Serial No. : 10/058,225
Filed : January 29, 2002
Title : ARMORED CABLE

Art Unit : Unknown
Examiner : Unknown

#6/IDS
7-EXAMUS
8-14-03

Commissioner for Patents
Washington, D.C. 20231

INFORMATION DISCLOSURE STATEMENT

Applicant submits the references listed on the attached form PTO-1449, copies of which are enclosed.

This statement is being filed within three months of the filing date of the application or before the receipt of a first Office action on the merits. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: July 18, 2002

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Serial No. : 10/058,225
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#5/IDS
DELAAS
8.14.03

Commissioner for Patents
Washington, D.C. 20231

INFORMATION DISCLOSURE STATEMENT

Applicant submits the references listed on the attached form PTO-1449.

Under 35 USC §120, this application relies on the earlier filing date of application serial number 09/482,340, filed on January 13, 2000. The references cited on the attached form PTO-1449 were submitted to and/or cited by the Office in the prior application and, therefore, are not provided in this application.

This statement is being filed within three months of the filing date of the application or before the receipt of a first Office action on the merits. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date:

July 1, 2002

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Assistant Commissioner for Patents
Washington, D.C. 20231

INFORMATION DISCLOSURE STATEMENT

There was a sale of spray-painted tubular sheaths by AFC Cable, Inc., more than one year before the filing date (April 8, 1992) as evidenced by the order entry forms attached as Exhibit A¹, but the "on sale" bar of 102(b) does not apply to the sale, as discussed below.

The product that was the subject of the sale was AFC Cable's standard helically-wound armored cable which was spray-painted with a non-conductive colored paint. Because the spray painting operation was an untested and poorly controlled process, the spray-painting produced a non-uniform, blotchy paint coating that was slow to dry, rubbed off when handled, coated only portions of the sheath while leaving other portions uncoated, and had regions where the paint ran and formed a thick coating. The inventors did not determine that the product that was sold would work for its intended purpose, e.g., in reliably providing a visible indicia different from the visual appearance of the outer surface of the sheath during handling, installation, inspection, and maintenance of the product. Furthermore, there was no controlled manner of providing conductivity between the sheath and connectors attached to the sheath during post-processing installation of the product. This concern was reflected in a memo from Jim Falciglia, one of the inventors, dated April 23, 1991 (Exhibit C): "[P]ainted armor could create problem with our U/L listing based on meeting some of the basic listing requirements ... Resistivity (Path to ground)."

¹ There was also a second sale of a spray-painted cable more than one year before the filing date (Exhibit B), but it is not known if this second order was ever filled.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

August 10, 2000
Date of Deposit _____
Signature Linda Vega
Linda Vega
Typed or Printed Name of Person Signing Certificate

Under the recent holding in Pfaff, the on-sale bar of 102(b) applies only if two conditions are satisfied before the critical date: 1) the product must be the subject of a commercial offer for sale; and 2) the invention must be ready for patenting. The second condition can be satisfied in two ways -- by proof of reduction to practice before the critical date or by proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention. Pfaff v. Wells Elec., Inc., 525 U.S. 55 (1998). See also Helifix Ltd. v. Blok-Lok, Ltd., 208 F.3d 1339 (Fed. Cir. 2000).

At least the second condition under Pfaff had not been met by the pre-critical date sale of the spray-painted cable. There were no pre-critical date drawings or other description that would have enabled a person skilled in the art to practice the invention. Furthermore, there was no reduction to practice before the critical date. A reduction to practice does not occur until the inventor has determined that the invention will work for its intended purpose. Isogen Corp. v. Amdahl Corp., 47 F.Supp.2d 415 (S.D.N.Y. 1998). "[T]he test for reduction to practice is whether the invention was known to work for its intended purpose" Id. n. 6, citing Mahurkar v. C.R. Bard, Inc., 79 F.3d 1572, 1578 (Fed. Cir. 1996). As discussed above, the inventors did not determine that the product that was sold would work for its intended purpose.

Applicants also submit the material listed on the attached form PTO-1449, copies of which are enclosed. This material was produced in litigation on the subject patent, AFC Cable Systems, Inc. & WPFY, Inc. v. Alflec Corporation, Civil Action No. 98-10425 MLW.

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